

**REMARKS**

The above-identified Office Action dated September 23, 2003 contained a final rejection of claims 1-16 and 18. Claims 10, 13 and 18 have been amended in this amendment, **not** in response to the rejections based on the cited references, but in an effort to **clarify the invention**. Therefore, the Applicants submit that a new search will **not** be required by the Examiner. As such, the foregoing amendments to the claims and the remarks below are intended to place the case in condition for allowance, or alternately in better form for consideration on appeal under 37 CFR 1.116. Therefore, it is respectfully requested that the amendments to claims 1 and 18 be entered despite the finality of the present rejection.

The Office Action rejected claims 1-16 and 18 under 35 U.S.C. §103(a) as being unpatentable over Daniels (U.S. Patent No. 6,373,500) in view of Jakobs et al. (U.S. Patent No. 5,892,509).

The Applicants respectfully traverse this rejection based on the arguments below. If **one** of the elements of the Applicant's invention is missing from or not taught in the cited references and the Applicant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. In Re Evanega, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987). In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.

Specifically, the cited references, when combined, are missing at least one material limitation of the Applicants' claimed invention. For example, the Daniels reference merely discloses a system with "...a switchbox that can be used to simultaneously display the output of two computers on a single monitor..."

In contrast, the Applicants' claimed invention includes **manipulating and sharing** data displayed on the display device between a first window of a first computer and a **picture within a picture window** of a second window of a second computer through a common memory buffer that provides the ability to **manipulate and share** data between the computers via the windows. According to case law and the MPEP, all of the claimed elements of an Applicant's invention **must be considered**.

When rejecting the claims, the Examiner stated that "...Daniels teaches share [sic] and manipulate data between windows..." but "...does not specifically teach how to share data between windows. However, it is well known in the art to obtain a common memory buffer between to [sic] computers through a network..." (see pages 5-6 of Paper No. 7). The Applicants submit that these statements by the Examiner are incorrect.

This is because, clearly nowhere in Daniels is the Applicants' claimed "...manipulating and sharing data...between the first window of the main computer and a picture within a picture window of the second window of the remote computer..." Instead, Daniels simply discloses the ability to toggle between a main display area and a picture in picture window. In particular, Daniels can only display two windows on one screen and simply toggle between the two windows, but cannot manipulate and share data between the windows, like the last element of claim 1. Hence, the combination of Daniels et al. with the Jakobs et al. reference does not disclose all of the elements of the Applicants' claims, and thus, cannot render the Applicants' invention obvious. In Re Evanega.

In addition, since Daniels discloses a system that uses a picture in picture device, but fails to disclose the Applicants' last element of claim 1 of "...manipulating and sharing data...between the first window of the main computer and a picture within a picture window of the second window of the remote computer..." and all of its advantages, is evidence in itself that Daniels does not render the Applicants' invention obvious. In Re Fine.

The Examiner is also reminded that she cannot use hindsight to assume the presence of the Applicants' manipulating and sharing data displayed on the display device between a first window of a first computer and a picture within a picture window of a second window of a second computer through a common memory buffer, when it is not disclosed in the cited references. Since the Examiner's rejection is clearly based on hindsight, the rejection is improper. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). The case law is well settled and forbids Examiners from taking a reference out of context and using the benefit of hindsight to make improper conclusions and manufacture elements that are not

disclosed in the combined references, which is clearly the situation in this case. Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Consequently, obviousness cannot be established by combining these references. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). *MPEP* 2143.01

Moreover, even though the combination of Daniels et al. and Jakobs et al. do not produce all of the elements of the claimed invention, as discussed above, these references should not even be considered together since there is no motivation to combine the cited references. Namely, Jakobs et al. teaches away from the Applicants' claimed invention. Although Jakobs et al. disclose "...coupling at least two image processing systems connected to a network..." and using "...both common and personal memory...", its use of the common memory teaches away from the Applicants' claimed invention.

For example, Jakobs et al. explicitly states that "...[T]he personal memory of each system contains one or more personal images that can be viewed only by the respective system...and that "...each system is controlled to access only its respective personal memory. [*emphasis added*].

Further, "...a common image is coupled to each system over the network and commonly displayed on each system..." however, although "...the common image is commonly displayed on each system, it is edited by the first image processing system..." [*emphasis added*]. In contrast, the last element of claim 1 does not have such constraints because it allows manipulation and sharing of data between a first window of a first computer and a picture within a picture window of a second computer with a display device through a common memory buffer.

As such, this "teaching away" cannot be ignored by the Examiner. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Namely, "it is impermissible within the framework of 35 U.S.C. 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly

Serial No.: 09/758,732  
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suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1965).

This **failure** of the cited references, either alone or in combination, to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (*MPEP 2143*).

Further, because the dependent claims depend from the above argued independent claims, and contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable over these references.

As the foregoing amendments to the claims do not raise new issues, it is the Applicant's position that they are entitled to have the changes entered to place this case in condition for allowance, or alternately, in better condition for consideration on appeal under 37 CFR 1.116. It is, therefore, respectfully requested that the changes to the claims be entered despite the finality of the present rejection.

Thus, it is respectfully requested that the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns.

Respectfully submitted,  
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